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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER	
TRUONG, THANH K	
ART UNIT	**PAPER NUMBER**
3721	

DATE MAILED: 11/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/659,246	HOOGLAND ET AL.	
	Examiner	Art Unit	
	Thanh K. Truong	3721	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 September 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *40-88* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *46* is/are allowed.

6)☒ Claim(s) *40-45 and 47-88* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on September 11, 2006 has been entered.

2. Applicant's cancellation of claims 1-39 is acknowledged.

3. **Examiner's note**: since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (June 12, 2005), the well known in the art statement in the office action of June 12, 2005 (regarding to claim 79) is taken to be admitted prior art.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 40-43, 50, 52, 55-58, 65, 67-71, 73-82, 85, and 87 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

Heiligers discloses a method for manufacturing a storage device (1) for a compact disc (CD) (2) (Heiligers et al. - page 5, lines 3-7), the storage device having a first cover and a second cover (3, 5) pivotally connected (at 6 with the intermediate part 4), and loading the plate-shaped data carrier in the storage device.

Heiligers discloses the claimed invention, but does not expressly disclose the positioning of the authentication means in the injection molding part.

Foulkes discloses the in-mold labeling technique in which a pre-formed polymeric label is incorporated into a polymeric article by molding the article in a mold containing the label providing an attractive appearance article and the label is difficult to remove (column 1, lines 13-19).

Wolpert discloses that in-mold labeling is an effective authenticating means to prevent counterfeiting and to secure valuable merchandise (column 1, lines 17-40), and Wolpert further discloses (column 4, lines 62-65) the authentication means comprising authentication information unique to the individual article and valuable merchandise (it is construed that include item such as CD) to be stored in the storage device.

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by incorporating the in-mold labeling as taught by Foulkes and Wolpert providing an attractive article with authenticating means being injection molding within the part that is difficult to remove and preventing counterfeiting of the article.

Heiligers, Foulkes and Wolpert further disclose: the storage device is injection molded in one piece (Heiligers – figure 1); the authentication means (such as bar code

16, 46b – Wolpert, figures 4A and 8); providing a printing and placing the printing (such as bar code) in the molding part and form an integral part of the cover; the printing is introduced into the mold on a carrier (Wolpert, figure 4A); the authentication means is a magnetic means which is postioned on a carrier in the mold, and injecting plastic around the magnetic means, such that the carrier is enclosed therein; a fixing means or resilient fingers (17) within the storage device for fixing the plate shaped data carrier in the storage device (Heiligers, figure 2a), and the data carrier is a CD (2); and the hinge (6) forming an integrated one piece hinge between the first and second cover.

Regarding to claim 79 (also see examiner's note on paragraph 3 above), it is obvious and well known for offering the data carrier house in the storage device to consumers for sale (admitted prior art). Furthermore, as Wolpert has clearly pointed out that the function of the authentication means is to prevent counterfeiting of the product and also to secure the "valuable merchandise" (column 1, lines 17-19), and the main purpose of the manufacturing industry is to produce products for sale in the markets for profit. Therefore, it would have been obvious to state that Heiligers, Foulkes and Wolpert further comprising offering the carrier housed in the storage device to consumer for sale.

6. **Examiner's note**: since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (June 12, 2005), the well known in the art statement in the office action of June 12, 2005 (regarding to claims 53 and 66) is taken to be admitted prior art.

7. Claims 53, 54 and 66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

Regarding claims 53 and 66 (also see examiner's note in paragraph 6 above), it is old and well known to provide a carrier having printing on both sides of the carrier (admitted prior art) so that the printing, such as bar code, can be seen on both sides of the carrier without being turn around.

Regarding claim 54, the carrier being at least partially transparent is inherent, because in order to read the bar code, the storage device needs to be at least partially transparent.

8. Claims 63 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 5 of this office action, Heiligers, Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the melting index of at least 30 and 50. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have performed the injection molding of Heiligers using the melt index as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

9. Claims 44, 45, 47-49, 59-62 and 82-84 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948), and further in view of Hanamoto et al. (4,639,341).

As discussed above in paragraph 5 of this office action, Heiligers, Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the placing of the carrier adjacent a wall of the mold and inject the plastic to contact the carrier and the mold wall.

Hanamoto discloses a method in which the carrier (32) with the printing indicia (10) is placed adjacent a wall of the mold and the plastic is injected to contact the carrier and the mold wall (figures 1-7). Hanamoto provides an effective method to molding articles by injection molding while simultaneously imprinting or transferring patterns on a continuous sheet on or to the molded articles (column 1, lines 14-17).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers' method by incorporating the molding articles with printing pattern as taught by Hanamoto providing an effective molding process that produce printing pattern on the injection molding article.

Hanamoto further discloses: the stretching of the carrier before placing the carrier in the mold so that the carrier is pulled taut (column 3, lines 52-62); the carrier fuses with the plastic; wherein the printing is designed as a transfer (column 1, line s 15-16).

10. Claims 51, 72 and 86 are rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986), Wolpert et al. (6,255,948), and further in view of Walters (5,815,292) and Palmer et al. (5,189,531).

As discussed above in paragraph 5 of this office action, Heiligers, Foulkes and Wolpert disclose the claimed invention, but do not expressly disclose that the printing further comprises providing a holographic printing.

Walters discloses that holograms are commonly used as authenticating devices because it provide a three-dimensional image, and thus it is difficult to reproduce (column 1, lines 15-17).

Palmer discloses that holograms are formed in moldable materials by utilizing injection molding can be applied to digital compact audio discs or video discs (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers, Foulkes and Wolpert method to include the hologram image as taught by Walters and Palmer to provide an authenticating devices that is difficult to reproduce.

11. **Examiner's note**: since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (February 14, 2006), the well known in the art statement in the office action of February 14, 2006 (regarding to claim 88) is taken to be admitted prior art.

12. Claim 88 is rejected under 35 U.S.C. 103(a) as being unpatentable over Heiligers et al. (WO 97/20315) in view of Foulkes (5,868,986) and Wolpert et al. (6,255,948).

As discussed above in paragraph 5 of this office action, the modified Heiligers, by Foulkes and Wolpert discloses the claimed invention, but do not expressly disclose the step of positioning a printer head adjacent a surface of an injection mold.

It is old and well known in the art to position a printer head adjacent a surface of an injection mold (admitted prior art – see examiner's note in paragraph 11 above) for a better controlling of the printing on the mold surface and therefore a better printing quality.

Wolpert discloses that the graphic indicia can be printed as line work or as halftone (Wolpert – column 5, lines 40-43), and the printing can be accomplished by using "multiple print stations" (Wolpert – column 7, lines 31-33). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have included the printer head adjacent to the surface of the injection mold for a better controlling of the printing on the mold surface and therefore a better printing quality.

Allowable Subject Matter

13. Claim 46 is allowed.

Response to Arguments

14. Applicant's arguments filed August 7, 2006 have been fully considered but they are not persuasive.

15. In response to the Applicant's argument regarding claims 40, 69, 78 and 88, the Applicant's stated that: none of the prior art references discloses an authentication link between the storage box and the enclosed CD/DVD, this is not found persuasive.

As discussed in the paragraph 5 of this office action, Heiligers discloses a method for manufacturing a storage device (1) for a compact disc (CD) (2) (Heiligers et al. - page 5, lines 3-7):

> *"a storage device according to the invention is particularly suitable for storing circular discs, such as compact discs (CD, CD-I, CD-ROM), video discs, long-playing records and singles, and the like."*, and

Wolpert (column 4, lines 58-65) discloses that:

> *"... the magnetic/metallic security device 10 authenticates and/or is encoded with data **relating** to the articles to which the labels or packaging material is attached"* (emphases added).

Clearly, the references in combination disclose the authentication link between the storage box and the enclosed CD/DVD as claimed.

16. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Helligers discloses a method for manufacturing a storage device as recited in the claimed

invention; Foulkes discloses the in-mold labeling technique in which a pre-formed polymeric label is incorporated into a polymeric article by molding the article in a mold containing the label providing an attractive appearance article and the label is difficult to remove (column 1, lines 13-19); and Wolpert discloses that in-mold labeling is an effective authenticating means to prevent counterfeiting and to secure valuable merchandise (column 1, lines 17-40). Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Helligers storage device by incorporating the in-mold labeling technique as taught by Foulkes and demonstrated by Wolpert that the in-mold labeling is an effective authenticating means to protect the storage device from counterfeiting and thefts (at the sale location).

17. In response to the Applicant's argument regarding claims 53 and 66, since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (June 12, 2005), the well known in the art statement in the office action of June 12, 2005 (regarding to claims 53 and 66) is taken to be admitted prior art.

18. In response to the Applicant's argument regarding claim 88, since the Applicant fails to challenge the Official Notice taken by the examiner in the previous office action (February 14, 2006), the well known in the art statement in the office action of February 14, 2006 (regarding to claim 88) is taken to be admitted prior art.

19. In response to the Applicant's argument (regarding claims 63 and 64), the examiner maintains that it would have been obvious to one having ordinary skill in the art at the time the invention was made to have performed the injection molding of Heiligers using the melt index as claimed by the applicant, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

20. In response to the Applicant's argument that:

> *"... Moreover, stretching of the label prior to positioning is not disclosed in Hanamoto. In Hanamoto the label is plastically deformed during placing, which is different from the feature of the present invention.",*

this is not found persuasive. The examiner maintains that the label is plastically deformed, and thus it is being construed as "stretching" as recited in the claimed invention.

21. In response to the Applicant's argument (regarding claims 51, 72 and 86) that:

> *"The Examiner has rejected Claims 51, 72 and 86 based on still further references, namely a further combination of Walters and Palmer. These additional references are relied upon for their disclosure of holograms. However, while Walters discloses holograms as commonly used authentication devices, this reference describe providing plastic layers by embossed or surface casts with contrasting surface relief diffraction patterns. Moreover, no disclosure is given of injection molding products with such embossing.*
> *Palmer discloses the use of holograms on digital compact audio discs or video discs. Again, this would lead a person skilled in the art towards authentication of the CD or DVD itself, as opposed to the storage box and would certainly not motivate one skilled in the art to establish an*

> *authentication link between the storage box and the DVD/CD. On the contrary, these documents would lead a person skilled in the art to the idea that providing authentication means on the CD/DVD itself would be sufficient for authentication purposes. Therefore, it would lead a person skilled in the art away from the present invention.",*

the examiner respectfully disagrees. The fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

The examiner maintain that: Walters discloses that holograms are commonly used as authenticating devices because it provides a three-dimensional image, and thus it is difficult to reproduce (column 1, lines 15-17).

Palmer discloses that holograms are formed in moldable materials by utilizing injection molding can be applied to digital compact audio discs or video discs (abstract).

Therefore, it would have been obvious to one having ordinary skill in the art, at the time applicant's invention was made, to have modified Heiligers, Foulkes and Wolpert method to include the hologram image as taught by Walters and Palmer to provide an authenticating devices that is difficult to reproduce.

Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thanh K. Truong whose telephone number is 571-272-4472. The examiner can normally be reached on Mon-Thru 8:00AM - 6:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on 571-272-4467. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Thanh K. Truong
Patent Examiner
November 23, 2006.